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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91152940
Party	Plaintiff SINCLAIR OIL CORPORATION SINCLAIR OIL CORPORATION ,
Correspondence Address	JOHN C. STRINGHAM WORKMAN, NYDEGGER & SEELEY 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111
Submission	Reply in Support of Motion
Filer's Name	Robyn L. Phillips
Filer's e-mail	rphillips@wnlaw.com,jgarcia@wnlaw.com
Signature	/Robyn L. Phillips/
Date	10/24/2006
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial No. 76/212,011
Published in the Official Gazette of May 28, 2002, on page TM 497, Int'l Class 35
Filed: February 20, 2001
Mark: STAACHI'S CO. 1996 & DESIGN

SINCLAIR OIL CORPORATION Opposer, v. SUMATRA KENDRICK Applicant.	Opposition No. 91152940 **REPLY TO APPLICANT'S "OPPOSITION" TO SINCLAIR'S MOTION FOR SUMMARY JUDGMENT**

In an Order mailed August 28, 2006, the Board granted Applicant's "Motion to Extend" and allowed Applicant an additional thirty (30) days from the date of the Order to file an Answer to the Amended Notice of Opposition and an Opposition to the Motion for Summary Judgment filed by Opposer Sinclair Oil Corporation ("Sinclair"). [*See* Paper No. 38.] In response to the Order, on September 27, 2006 Applicant filed a document entitled "Amendment to Notice of Opposition." [*See* Paper No. 39.] It is unclear what exactly this document is and to which motion or document Applicant's "Amendment to Notice of Opposition" is responsive. Sinclair is erring on the side of caution and submits this response.

I. Applicant's "Amendment to Notice of Opposition" Cannot be Construed as an Opposition, Accordingly Opposer's Motion for Summary Judgment is Unopposed.

Contrary to the Order from this Board, Applicant failed to file an opposition to Sinclair's Motion for Summary Judgment. Applicant's "Amendment to Notice of Opposition" is three paragraphs and fails to address the issues raised in Sinclair's Motion for Summary Judgment.

Accordingly, Sinclair submits that the "Amendment to Notice of Opposition" cannot be reasonably construed to be an opposition to the motion for summary judgment. Therefore, Sinclair's Motion for Summary Judgment stands unopposed and pursuant to the rules may be treated as conceded. *See* 37 CFR § 2.127(a).

II. Even if Applicant's "Amendment to Notice of Opposition" is Somehow Construed as an Opposition, Applicant has Failed to Raise a Material Question of Fact.

Assuming that Applicant's "Amendment to Notice of Opposition" is construed as an Opposition to Sinclair's Motion for Summary Judgment, Opposer Sinclair Oil Corporation ("Sinclair") respectfully submits that Applicant has not raised a material issue of fact and Sinclair's Motion for Summary Judgment should be granted.

A. Applicant Does Not Dispute That She Admitted That She Had Not used the Mark in Commerce.

Applicant's Opposition to Sinclair's Motion for Summary Judgment does not rebut the simple fact that Applicant admitted in response to Sinclair's Interrogatories and Requests for Admission that Applicant's mark had not been used in commerce. [*See* Sinclair's Motion for Summary Judgment, at 6-8.] This evidence of record compels granting Sinclair's' Motion. Further, in this most recent filing Applicant has submitted nothing more than a conclusory and self-serving subjective statement that "[t]he Answer was mistakenly filed as I had not used my mark in commerce. I would like to point out, that there was confusion with question (sic)." [*See* Paper No. 39, at 1.]

This statement is not evidence and is not sufficient to create a genuine issue of fact. *See Techsearch, L.L.C. v. Intel Corp.*, 286 F.3d 1360, 1372, 62 USPQ2d 1449, 1456 (Fed. Cir. 2002) ("Mere denials or conclusory statements are insufficient."). Applicant must come forward with something more than a mere denial a conclusory statement that this was a "mistake." *See* Rule 56(e) and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (When the moving party has met this burden, and the evidence so identified by the moving party would be sufficient, in the absence of any opposing evidence, to establish the moving party's right to judgment, the nonmoving party may not rest upon the mere allegations or

denials in its pleadings, but rather must proffer countering evidence sufficient to show that there is a genuine issue for trial.).

As shown in Sinclair's Motion for Summary Judgment, Applicant did not just answer one interrogatory stating that the mark was not used in commerce. [*See generally* Sinclair's Motion for Summary Judgment, at 6-8, *see also* Exh. E, Responses to Interrogatory Nos. 2-36.] In fact, Applicant made this statement in response to Interrogatory Nos. 1 and 3. [*Id.* at 6-7.] In response to Interrogatory No. 3, Applicant stated "The name and mark "STAACHI'S & CO. 1996" **has never been used in commerce**." [Sinclair's Motion for Summary Judgment, at Exh. E, at 6 (emphasis added).] In response to Interrogatory No. 1, Applicant asserts:

> Applicant is in the formation stage of her business and has not been able to acquire any additional funding to allow her to conduct her business in commerce. **Applicant has not engaged in commerce**, but has only attempted to reserve the name and sought a trademark to protect the utilization of the mark when and if her business is opened.

[Sinclair's Motion for Summary Judgment, at 6-7 and Exh. E, at 1, para. no. 3 (emphasis added); *see also* Exh. E, Responses to Interrogatory Nos. 2-36.] Further, Applicant's responses to Interrogatory Nos. 6, 7 and 12 are completely consistent with Applicant's answer to Interrogatory No. 3 which she now asserts was made in mistake.

B. Even if Applicant Did Make a Mistake Answering an Interrogotory, The Other Evidence Submitted in Sinclair's Motion for Summary Judgment Shows That Applicant has not used the Mark in Commerce.

Even assuming Applicant's statement that there was confusion regarding the interrogatory about whether Applicant had used the mark in commerce (Interrogatory No. 3), which Opposer asserts there was not, the answers to other interrogatories are consistent with Applicant's "mistake". These responses were answered under oath. Further, Applicant responded to Requests for Admission which are likewise consistent with the responses to the interrogatories. For example, in response to Request for Admission No. 13 stating "Admit that Applicant has not engaged in commerce with products bearing the mark 'STAACHI'S & CO. 1996' with DESIGN", Applicant responded with an admission. [Sinclair's Motion for Summary Judgment, Exh. G, at 6 and Exh. H, at 3.] Further, when asked to "[a]dmit that the name and

mark 'STAACHI'S & CO. 1996' has never been used in commerce" in Request for Admission No. 15, Applicant, similarly responded in with an admission. [Sinclair's Motion for Summary Judgment Exh. G, at 6 and Exh. H, at 3.]

Accordingly, as clearly shown by these few examples, Applicant's subjective after the fact attempt to change her response to the interrogatories so as to create an appearance of a question of fact is inconsistent with the other evidence in the case. Accordingly, Applicant's "Amendment to Notice of Opposition" has failed to rebut the evidence of record showing that Applicant's mark fails to meet the requirements for registration. Further, the "Amendment to Notice of Opposition" filed by Applicant does not overcome the showing by Sinclair that the March 20, 1996 date of first use claimed by Applicant corresponds instead to the date of filing by Applicant of a California Fictitious Business Name of "STaaCHi's Exclusives," which is not even the mark at issue in this proceeding. [*See* Sinclair's Motion for Summary Judgment, Exh. F (compare "STaaCHi's Exclusives" with "STACCHI'S CO. 1996 & DESIGN").] As such, Sinclair's assertion of fraud on the United States Patent and Trademark Office ("USPTO") stands unrebutted.

The relevant inquiry to determine whether Applicant has committed fraud on the USPTO is not Applicant's subjective intent, but the objective manifestations of that intent. *Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003). "[I]t is difficult, if not impossible, to prove what occurs in a person's mind, and that intent must often be inferred from the circumstances and related statement made by that person." *First Int'l Servs. Corp. v. Chuckles, Inc.*, 5 U.S.P.Q.2d 1628, 1636 (TTAB 1988). Applicant knew what name she filed in California as a fictitious business name. [*See* Exh. F.] Applicant also knows that name of the California business was different from her Mark before the USPTO. Likewise, Applicant knew at that time that she had never engaged in commerce, much less used the Mark in commerce. As a result, Applicant's representation to the Board that she had used the Mark in commerce since March 20,

1996 was made knowingly.[1] In any event, Applicant's knowledge or reckless disregard for the truth concerning the fact that her Mark had not been used in commerce, her knowledge that the business registration was not for the Mark, and the date of first use Applicant provided to the USPTO was for a name different than the Mark, all show an intent to commit fraud in the procurement of a registration. *See Medinol Ltd.*, 67 U.S.P.Q.2d at 1210.

III. Conclusion.

Sinclair respectfully submits that the "Amendment to Notice of Opposition" cannot be reasonably construed to be an Opposition to Sinclair's Motion for Summary Judgment and as a result, Sinclair's Motion for Summary Judgment stands unopposed and may be treated as conceded. Further, even if the "Amendment to Notice of Opposition" is somehow construed to be an opposition Applicant has failed to raise an issue of material fact and Sinclair's Motion for Summary Judgment should be granted.

DATED this 24th day of October, 2006.

By: Robyn L. Phillips

John C. Stringham, Registration No. 40,831
Robyn L. Phillips, Registration No. 39,330

WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

Attorneys for Opposer
SINCLAIR OIL CORPORATION

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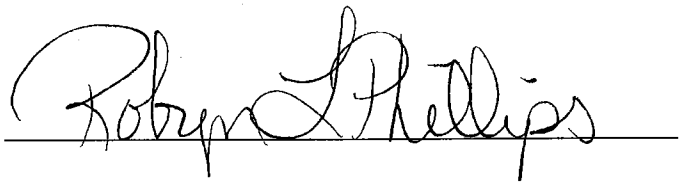
[1] Further, allowing Applicant to change the Application to an intent-to-use application does not remedy the alleged fraud upon the USPTO. *See Medinol Ltd.*, 67 U.S.P.Q.2d at 1208 (holding deleting the goods upon which the mark had not yet been used does not remedy the fraud on the USPTO due to the filing of a false statement of use.) Applicant's application is *void ab initio*.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **REPLY TO APPLICANT'S "OPPOSITION" TO SINCLAIR'S MOTION FOR SUMMARY JUDGMENT** was served on Applicant by mailing a true copy thereof to its attorney of record, by First Class Mail, postage prepaid, this 24th day of October, 2006, in an envelope addressed as follows:

Sumatra Kendrick
P.O Box 21055
El Sobrante, California 94820



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